

IV. REMARKS

The Examiner states on page 2 of the Office Action mailed January 29, 2004 that claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

In response to Examiner's rejection, Applicant has herein amended claim 19 to claim "said top surface of said metallic electrical junction box" to establish proper antecedent basis.

The Examiner further states on page 2 of the Office Action that claims 1-9, 11, and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,892,211 to Jorgensen (hereinafter Jorgensen).

Applicant respectfully traverses.

According to the Federal Circuit, "anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration" [W.L. Gore & Associates v. Garlock, Inc., 721 F.2d, 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)].

Presented below in tabular form are direct element-by-element comparisons of the elements of the amended Claim 1 of the instant application to the teachings of Jensen.

Table 1 – Element-by-element comparison of elements of amended Claim 1 of the present application to the teachings of Jorgensen.

Element in Claim 1	Difference or Agreement with Jorgensen
A. A prepackaged mounting assembly for securing a fixture of the type having a connection member and apertures therein to an overhead support comprising	Agree.
B. an electrical junction box including a top wall having a top surface and a bottom surface;	Agree.
C. said top wall including a downward extending peripheral side wall having a bottom edge and defining an interior volume;	Agree.
D. a first opening in said electrical junction box extending from said bottom surface;	No. Jorgensen's threaded holes 46 and 48 do not extend from his bottom surface (see Fig. 3) but are simply bores through the top wall portion 12. As stated in the present application "the first opening 38 of the prepackaged mounting assembly 20 of typically includes a peripheral wall 56 extending downward from the bottom surface 30 of the top wall 26" (page 11, lines 15-17 and see Fig. 4). Jorgensen's threaded holes do not extend downward.
E. a first fastener having a major thread diameter, said first fastener frictionally engaged in said first opening for temporary storage of said first fastener with said electrical junction box prior to installation;	No. Jorgensen does not claim a fastener engaged in threaded holes 46 and 48 as an element of his ceiling box 10. The current application, by including first fasteners as an element of the invention, satisfies one of the objectives of the invention which is to "provide a mounting assembly having all the required hardware for securing an electrical fixture to an overhead rafter" (page 5, lines 16-18 of application) and to provide "a means of holding the fasteners securely until needed at the job site, so that there will be no loss or displacement of fasteners during storage or shipment. (Page 6, lines 4-6 of application).

Element in Claim 1	Difference or Agreement with Jorgensen
F. apertures in said top wall;	Agree.
G. integral extensions on said side wall extending into said interior volume, said integral extensions including apertures in vertical alignment with said apertures in said top wall;	Agree.
H. said apertures in said integral extensions and said apertures in said top wall having a larger width than said major thread diameter of said first fastener;	<p>No. Jorgensen discloses that “top wall portion 12 has a pair of threaded cylindrical mounting screw holes 46 and 48, which are axially aligned with holes 40 and 42, ...and threadedly receive mounting screws 44 and 45 for securing the fan housing 50 to the ceiling box 10.” (Col. 2, lines 57-62). Jorgensen further discloses “the ceiling box is the sole support for the ceiling fan” (Col. 1, lines 7-8) and “the invention relates to improving the resistance to fatigue of ceiling box mounting flanges resulting from the dynamic loads of an unbalanced ceiling fan” (Col. 1, lines 8-11). Therefore Jorgensen’s apertures 46 and 48 in the top wall are mounting screw holes that support the weight of a suspended load whereas the present invention includes apertures of a larger width than the major thread diameter of the fasteners thereby satisfying one of the purposes of the invention which is “the load support screws go directly into the ceiling rafter, so that no portion of the load is supported by the electrical box itself but rather is supported entirely by the ceiling structure” (page 6, lines 1-14 of application).</p>
I. a second opening in said electrical junction box extending from said bottom surface; and	Agree.

Element in Claim 1	Difference or Agreement with Jorgensen
J. an initial fastener frictionally engaged in said second opening, said initial fastener extending no further than said top surface of said electrical junction box	No. Jorgensen does not disclose an initial fastener engaged in a second opening. Jorgensen discloses that “a plurality of auxiliary holes 31-36 extend through the top wall portion” (Col. 2, lines 43-45) but there is no disclosure of a fastener frictionally engaged therein.
K. whereby said larger width of said apertures in said integral extensions and said apertures in said top wall enable said fixture to be supported entirely by said first fasteners and said overhead support.	No. Jorgensen’s apertures 46 and 48 in the top wall portion 12 are threaded and “threadedly receive mounting screws 44 and 45 for securing the fan housing 50 to the ceiling box 10” (Col. 2, lines 61-62). Jorgensen further states “ the ceiling box is the sole support for the ceiling fan ” (Col. 1, lines 7-8).

Analysis of the element-by-element comparison of Claim 1 of the present invention to the teachings of Jorgensen:

Reference to Table 1 above shows that several elements (D, E, H, J, and K) of the present invention are missing in Jorgensen.

Referring to element D in Table 1, Jorgensen’s threaded holes 46 and 48 do not extend from the bottom surface of his top wall portion. The present invention includes a peripheral wall 56 (see Fig. 4) that surrounds the apertures 42 in the top wall 26 and these extend from the bottom surface 30 as shown in Fig. 4. The peripheral wall 56 helps the mounting assembly of the present invention meet its objective of providing “a means of holding the fasteners securely until needed at the job site, so that there will be no loss or

displacement of fasteners during storage or shipment. (Page 6, lines 4-6 of application). It should be noted that the first openings 38 in the current invention are not permanent receptacles for the first fasteners 40, but rather just temporary storage locations. The peripheral wall 56 surrounding the temporary storage locations or first openings 38 provide a much larger surface for the first fasteners 40 to be frictionally held “during storage and shipment of the box” as stated on page 4, line 11 of the application.

Jorgensen does not disclose element E, which is “a first fastener having a major thread diameter, said first fastener frictionally engaged in said first opening for temporary storage of said first fastener with said electrical junction box prior to installation” (row E, Table 1). Jorgensen does not include first fasteners as an element of his ceiling box 10.

Jorgensen does not disclose element H, “apertures in the integral extensions and apertures in the top wall having a larger width than the major thread diameter of the first fastener. Jorgensen clearly states that his “ceiling box is the sole support for the ceiling fan” (Col. 1, lines 7-8), which is opposite of the present invention. The present invention discloses apertures of a larger width than the major thread diameter of the fasteners, thereby satisfying one of the purposes of the invention which is “the load support screws go directly into the ceiling rafter, so that no portion of the load is supported by the electrical box itself but rather is supported entirely by the ceiling structure” (page 6, lines 11-14 of application).

Jorgensen makes no disclosure of “an initial fastener frictionally engaged in the second opening” (element J). As stated in the application “an initial fastener is provided in the top wall for initially securing the assembly to the overhead support and thus freeing

the installer's hands for subsequent installation steps" (page 7, lines 7-9). There is no initial fastener element disclosed in Jorgensen.

Jorgensen's ceiling box is not "supported entirely by the first fasteners and the overhead support" (element K). Jorgensen discloses that "the ceiling box is the sole support for the ceiling fan" (Col., 1, lines 7-8).

Since several elements of claim 1 are not disclosed in the single prior art reference cited, there is no anticipation by Jorgensen.

As a consequence of adding the limitation the first fastener having a major thread diameter (element E) and the apertures in the integral extensions and the apertures in the top wall having a larger width than the major thread diameter of the first fastener (element H), claims 3-6, which previously included these limitations, are herein canceled.

It is now believed that claims 7-11 and 15-18, which all depend from claim 1 or an intermediate of claim 1, should be allowable as a result of the amendment to claim 1.

Claim 19 has been amended to include the same limitations added by amendment to claim 1. Applicant believes claim 19 should now be allowable.

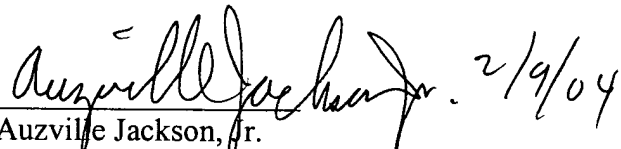
In response to the Examiner's rejection of claims 12-14 under 35 U.S.C. 103(a) as being unpatentable over Jorgensen (US 4,892,211) in view of Reiker (US 6,303,862), Applicant has herein canceled claims 12-14.

V. CONCLUSION

Based on the amendment and cancellation of claims as presented herein, Applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims.

Should the Examiner require any further information by Applicant or Applicant's undersigned representative regarding this response, the Examiner is invited to telephone the undersigned at the number set forth below.

Respectfully submitted,


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